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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
097622,815	08/23/00	ASAKAI	R 060577

HM12/1026
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EXAMINER	
HIGEL, F	
ART UNIT	PAPER NUMBER
1626	4

DATE MAILED: 10/26/01

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1 TO 19 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1 TO 19 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1 TO 19 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

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Receipt is acknowledged of the preliminary amendment and information disclosure statement filed August 23, 2000, which have been entered in the file.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 to 19 are rejected under 35 USC 112, second paragraph, for failing to properly define the invention. The inapt expression "an indole derivative" must be changed to an indole compound. The expression "which may possess substituents" (should be which is unsubstituted or substituted) "may be combined to form " (should be when combined form), "preventing progress of symptoms", "through inhibiting death of neurons, ...", "through inhibiting death of myocardial cells", "through inhibiting death of hepatic cells", "through inhibiting death of renal

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cells”, “through inhibiting excessive death of T-cells”, “through inhibiting cell death of ...”, “disorders” disorders or side effects due to toxic agents”, “through inhibiting death of neurons, of prior diseases”, “preventing functional deficiency of transplanted organs ... or cells” and “cell death inhibiting substances” render the claims indefinite by placing no definite limits or.

This application contains inventions or groups of invention which are not so linked as to form a single inventive concept under PCT Rule 13.1.

I. Claims 1 to 16 and 19 drawn to indole compound and compositions and their use to inhibit cell death thereof classified in class 548, subclass 466.

II. Claim 17 to a preservative for organs, classified in class 422, subclass 28.

III. Claim 18 drawn to an assay method for cell death classified in class 436 subclass 96.

The claims lack unity of invention, each from the other because: The claims herein lack unity of invention under PCT Rule 13.1 and 13.2 since the compounds defined in the claim lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art. The compound contain indole group which does not define a contribution over the prior art. The and alkoxy substituents result in vastly, different compounds. Accordingly, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered proper. 1.475(b) an international or a national stage application containing claims drawn to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combination of categories.

(1) A product and a process specifically adapted for the manufacture of said product; or

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(2) A product and process of use of said product, or

(3) A product, a process specifically adapted for the manufacture of the said product, and
a use of said product, or

(4) a process and an apparatus or means specifically designed for carrying out the said
process; or

(5) A product, a process specifically adapted for the manufacture of the said product, and
an apparatus or means specifically designed for carrying out the said process.

(c) If an application contains claims to more or less than one of the combination of
categories of inventions set forth in paragraph (b) of this section, unity of invention might not be
present.

(d) If multiple products, processes, of manufacture, or uses are claimed, the first invention
of the category first mentioned in the claims of the application and the first recited invention of
each of the other categories relied thereto will be considered as the main invention in the claims.

(e) The determination whether a group of inventions is so linked as to form a single
general inventive concept shall be made without regard to whether the inventions are claimed in
separate claim or as alternates within a single claim.

Once applicants have elected the compounds from either Groups I, II or they are
permitted to have, in view of the fact that this application enters the national stage through 35
USC 371, no more than one process of preparing that elected product. See PCT Rule 13.2.

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Because these inventions lack unity of invention for the reasons given above and have acquired a separate status in the are because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

In re Weber, USPQ (332), In re Hengehold 169 USPQ (437), was noted for the proposition that as long as applicants have maintained the right (as they do here) to file the nonelected subject matter in divisional applications then restriction is proper, as to that point.

Applicants may file the divisional subject matter noted in divisional applications.

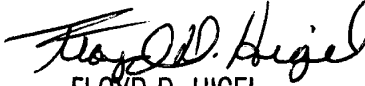
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must accompanied by a diligently-filed petition under 37 CFR 1.48 (b) and by the fee required under 37 C.F.R. 1.17(h).

No claim is allowed.

Any inquiry concerning this communication should be directed to Examiner Floyd D. Higel at telephone number (703) -308-4530.

Higel/LR

October 24, 2001


FLOYD D. HIGEL
PATENT PRIMARY EXAMINER
ART UNIT 128/626